

ESTTA Tracking number: **ESTTA209531**

Filing date: **05/06/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048989
Party	Plaintiff Top Tobacco, L.P
Correspondence Address	Antony J. McShane Neal, Gerber & Eisenberg LLP Two North LaSalle Street, Suite 2200 Chicago, IL 60602 UNITED STATES apeterson@ngelaw.com, lhirshfeld@ngelaw.com, amcshane@ngelaw.com, gleighton@ngelaw.com
Submission	Other Motions/Papers
Filer's Name	Antony J. McShane
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Signature	/Antony J. McShane/
Date	05/06/2008
Attachments	Motion for Partial Judgment.pdf (17 pages)(573732 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF TRADEMARK
REGISTRATION NOS. 1,686,628,
2,950,896, and 3,328,623

TOP TOBACCO, LP)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92048989
)	
VAN NELLE TABAK NEDERLAND BV,)	
)	
Respondent.)	

**MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS
AND OPPOSITION TO RESPONDENT'S MOTION TO DISMISS**

Top Tobacco, L.P. ("Top Tobacco") petitioned the Trademark Trial and Appeal Board to cancel Registration Nos. 1,686,628, 2,950,896 and 3,328,623 for the mark ROUTE 66 (in block and design forms) based upon Respondent's abandonment of the mark. In response, Respondent filed its Answer to Consolidated Petition and a Motion to Dismiss the Petition for Cancellation of the '628 Registration because the "registration expired and should have been cancelled by the Director long ago." See Motion to Dismiss, p. 1. The registration remains on the Principal Registers, however, and Respondent has twice claimed ownership of it as an active registration, first in the prosecution of the application resulting in Registration No. 2,950,896, and later in the prosecution of the application resulting in Registration No. 3,328,623. The matter cannot therefore be considered moot, as Respondent suggests. Rather, Respondent's Motion should be deemed an admission that the registration should be cancelled, and judgment sought by Top Tobacco with respect to the '628 Registration should be granted.

Accordingly, Top Tobacco hereby moves the Board for a partial judgment on the pleadings in favor of Top Tobacco and against Respondent. Applicant further requests that the Board cancel the '628 Registration, denying Respondent's Motion to Dismiss and order that these proceedings continue as to Registration Nos. 2,950,896 and 3,328,623.

In support further thereof, Top Tobacco states as follows:

1. On March 6, 2008, Top Tobacco filed a Consolidated Petition to Cancel Registration Nos. 1,686,628 for the mark ROUTE 66 & Design, Registration No. 2,950,896 for the mark ROUTE 66 ORIGINAL & Design, and Registration No. 3,328,623 for the mark ROUTE 66 on the ground that the registrations are subject to cancellation pursuant to 15 U.S.C. §§ 1064, 1126 and 1127. Respondent has moved to dismiss the petition as to the '628 Registration only on the basis that the proceeding is moot. As support for its motion, Respondent states only that the registration "has expired and should have been cancelled by the Director long ago." Motion to Dismiss, p. 1.

2. As reflected from the attached printout from the United States Patent and Trademark Office records (see Exhibit A hereto), however, the '628 remains active on the Principal Registry, and, to date, Respondent has not sought to cancel it. To the contrary, since May 12, 2002, when the registration was due to be renewed, Respondent has twice relied upon the registration being active, by claiming it as part of the basis for subsequent applications for the mark ROUTE 66, neither of which claim use of the mark but are instead based on extensions of foreign registrations for the mark. Thus, on October 16, 2003, in connection with the Application Serial No. 76/487,927, which resulted in Registration No. 2,950,896, Respondent relied upon the continued subsistence of, and claimed ownership of, the '628 Registration, as

well as another registration which has been cancelled for non-use.¹ See Exhibit B, hereto. It then asserted that it would be “unreasonable and unjust” to refuse its application in light of its ownership of these prior registrations. *Id.* Similarly, on June 7, 2007, in connection with its Application Serial No. 77/105,156, which resulted in Registration No. 3,328,623, Respondent again relied upon the continued subsistence of, and claimed ownership of, the ‘628 Registration. See Exhibit B hereto.

3. Whatever the implications of Respondent’s failure to advise the Trademark Office that the ‘628 Registration incorrectly remained on the Principal Registry, and its repeated filing of applications for the mark ROUTE 66 despite its non-use of the mark and the expirations of its registrations therefor, its Motion to Dismiss must be deemed consent to the cancellation of the ‘628 Registration. Indeed, Respondent concedes that the registration “expired and should have been cancelled by the Director long ago.” Motion to Dismiss, p. 1. Thus, the parties are in agreement that the ‘628 Registration was abandoned by Respondent, and, as a result, should be cancelled by the Director or this Board.

4. Respondent’s Motion should be denied. Despite the passage of many years, the Director has not cancelled the registration. Moreover, rather than remedy the matter, Respondent continues to rely upon the registration to prosecute further applications for registration of the mark ROUTE 66. Indeed, under the circumstances, the most expedient and just resolution of this matter as it relates to the ‘628 Registration is to deny Respondent’s motion and grant Top Tobacco’s Motion for Partial Judgment on the Pleadings.

¹ In the same Office Action Response, Respondent also claimed ownership of Registration No. 2,442,437, for the mark ROUTE 66, for cigarettes and lighters. This registration was cancelled September 27, 2007 for failure to file a affidavit of use pursuant to Section 8 of the Lanham Act, 15 U. S. C. § 1058.

5. Indeed, a judgment on the pleadings may be granted where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment as a matter of law on the substantive merits of the controversy. *See Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); TBMP § 504.02.

6. Here, there is no genuine issue of material fact to be resolved because the Respondent concedes that the '628 Registration was not renewed, has expired, and should be cancelled. Accordingly, Top Tobacco is entitled to judgment in its favor, and, hereby respectfully requests that this Board (i) enter a judgment on the pleadings granting its Petition to Cancel the '628 Registration, (ii) direct that the '628 Registration be cancelled, and (iii) order that this matter proceed with respect to Registration Nos. 2,950,896 and 3,328,623

Dated: May 6, 2008

/Antony J. McShane/
One of the Attorneys for Applicant,
DRL Enterprises, Inc.

Antony J. McShane
Lara V. Hirshfeld
Gregory Leighton
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street, Suite 2200
Chicago, Illinois 60602
(312) 269-8000

CERTIFICATE OF SERVICE

I, Antony J. McShane, an attorney, state that I caused a copy of the foregoing Motion for Partial Judgment on the Pleadings and Opposition to Respondent's Motion to Dismiss, to be served upon:

Brewster Taylor, Esq.
Stites & Harbison PLLC
1199 North Fairfax Street, Suite 900
Alexandria, VA 22314

via Federal Express on this 6th day of May, 2008.

/Antony J. McShane/

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

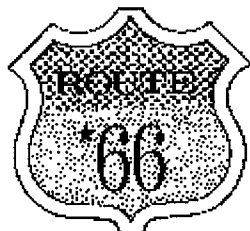
This page was generated by the TARR system on 2008-05-06 13:59:21 ET

Serial Number: 73745820 Assignment Information

Trademark Document Retrieval

Registration Number: 1686628

Mark



(words only): ROUTE 66

Standard Character claim: No

Current Status: A cancellation proceeding has been filed at the Trademark Trial and Appeal Board and is now pending.

Date of Status: 2008-03-07

Filing Date: 1988-08-12

Transformed into a National Application: No

Registration Date: 1992-05-12

Register: Principal

Law Office Assigned: LAW OFFICE 14

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2007-10-15

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. NAVIGATOR INC.

Address:

NAVIGATOR INC.

EURO-CANADIAN CENTRE MARLBOROUGH ST., 1ST FLOOR
NASSAU
Bahamas
Legal Entity Type: Corporation
State or Country of Incorporation: Bahamas

GOODS AND/OR SERVICES

International Class: 032
Class Status: Section 8 - Cancelled
Basis: 44(e)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 034
Class Status: Active
CIGARETTES, LIGHTERS
Basis: 44(e)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Lining and Stippling: THE STIPPLING SHOWN IN THE DRAWING OF THE MARK IS FOR SHADING PURPOSES ONLY.

Design Search Code(s):

- 01.01.03 - Star - a single star with five points
- 24.01.02 - Shields or crests with figurative elements contained therein or superimposed thereon
- 24.01.03 - Shields or crests with letters, punctuation or inscriptions contained therein or superimposed thereon
- 24.01.04 - Shields or crests with numbers contained therein or superimposed thereon
- 25.03.05 - Backgrounds covered with dots; Dotted backgrounds

Foreign Application Number: 1343470
Foreign Registration Number: A1343470
Foreign Registration Date: 1988-05-05
Country: United Kingdom
Foreign Filing Date: 1988-05-05
Foreign Expiration Date: 1995-05-05

Foreign Application Number: 1343468
Foreign Registration Number: A1343468
Foreign Registration Date: 1988-05-05
Country: United Kingdom
Foreign Filing Date: 1988-05-05
Foreign Expiration Date: 1995-05-05

Foreign Application Number: 1343469

Foreign Registration Number: A1343469
Foreign Registration Date: 1988-05-05
Country: United Kingdom
Foreign Filing Date: 1988-05-05
Foreign Expiration Date: 1995-05-05

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-03-07 - Cancellation Instituted No. 999999

2007-10-15 - Case File In TICRS

1999-05-25 - Cancellation terminated for Proceeding

1999-05-25 - Cancellation dismissed for Proceeding

1998-08-06 - Partial Section 8 (6-year) accepted

1998-05-07 - Section 8 (6-year) filed

1996-07-02 - Cancellation Instituted No. 999999

1992-05-12 - Registered - Principal Register

1992-02-18 - Published for opposition

1992-01-17 - Notice of publication

1991-08-27 - Approved for Pub - Principal Register (Initial exam)

1991-07-31 - Communication received from applicant

1991-02-14 - Non-final action mailed

1990-12-07 - Communication received from applicant

1990-06-11 - Inquiry as to suspension mailed

1990-06-08 - Assigned To Examiner

1989-07-12 - Letter of suspension mailed

1989-07-07 - Non-final action mailed

1989-04-27 - Communication received from applicant

1988-10-28 - Non-final action mailed

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

BREWSTER TAYLOR

Correspondent

Brewster Taylor

Larson & Taylor

1199 North Fairfax Street, Suite 900

Alexandria, VA 22314-1437

Domestic Representative

LARSON & TAYLOR

EXHIBIT B



XXII/T04828US00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of	}	
	}	
VAN NELLE TABAK NEDERLAND BV	}	EXAMINING ATTORNEY
	}	MATTHEW J. PAPPAS
Serial No.: 76/487,927	}	
	}	LAW OFFICE 105
Filed: FEBRUARY 7, 2003	}	
	}	BOX 5
Mark: ROUTE 66 ORIGINAL plus design	}	

AMENDMENT

To The Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

S I R:

In response to the Office Action of July 30, 2003, Applicant requests that the above-identified application be amended as follows.

(1) Please delete the identification of goods in the application and substitute therefor the following:

--INT. CL. 34: TOBACCO WHETHER MANUFACTURED OR UNMANUFACTURED; TOBACCO PRODUCTS, NAMELY, HAND-ROLLING TOBACCO, CIGARS, CIGARETTES; TOBACCO SUBSTITUTES, NONE BEING FOR MEDICINAL OR CURATIVE PURPOSES; SMOKERS' ARTICLES, NAMELY, CIGARETTE LIGHTERS NOT OF PRECIOUS METAL, ASHTRAYS NOT OF PRECIOUS METAL, CIGARETTE PAPERS, MATCHES.--

(2) Immediately preceding the Power of Attorney, please insert the following statements:

--Applicant is the owner of U.S. Trademark Registration Nos. 1,686,628 and 2,422,437.

The mark includes the wording "ROUTE 66 ORIGINAL", a fanciful ribbon and shield design, and a fanciful map of a portion of the western United States including Route 66 with a shield and the highway designation number 66.

The stippling in the drawing is a feature of the mark and is not intended to indicate color.



10-16-2003

No claim is made to the exclusive right to use "ORIGINAL" apart from the mark as shown.--


REMARKS

Applicant has amended the application in response to the requirements of the Examining Attorney.

With respect to the prior cited applications, Applicant respectfully submits that in view of Applicant's ownership of the two prior registrations of "ROUTE 66" and "ROUTE 66" plus design for tobacco products (U.S. Trademark Registration Nos. 2,422,437 and 1, 686,628) registration of Applicant's above mark should not be suspended pending disposition of the cited applications, since, clearly, even in the event that the applications were to issue as registrations over Applicant's prior registrations, it would be unreasonable and unjust to then refuse registration on Applicant's current application.

Finally, in response to the Examining Attorney's inquiry, Applicant advises that it will continue to rely both on the priority of the corresponding European Community trademark application and on "intent to use". A true copy of the eventual European Community trademark registration will be submitted as soon as possible after it issues.

Respectfully Submitted,
LARSON & TAYLOR, PLC



Brewster Taylor October 16, 2003

1199 North Fairfax Street
Suite 900
Alexandria, Virginia 22314

Telephone: (703) 739-4900
Facsimile: (703) 739-9577

EXHIBIT C

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77105156
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
OWNER SECTION (current)	
NAME	VAN NELLE TABAK NEDERLAND BV
STREET	SLACHTEDIJK 28A
CITY	8501 ZA JOURE
COUNTRY	NL
OWNER SECTION (proposed)	
NAME	VAN NELLE TABAK NEDERLAND BV
STREET	SLACHTEDIJK 28A
CITY	8501 ZA JOURE
COUNTRY	Netherlands
LEGAL ENTITY SECTION (current)	
TYPE	CORPORATION
LEGAL ENTITY SECTION (proposed)	
TYPE	CORPORATION
STATE/COUNTRY OF INCORPORATION	Netherlands
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	034
DESCRIPTION	
CIGARETTES, CIGARS, CIGARILLOS, TOBACCO, MATCHES, LIGHTERS AND ASHTRAYS NOT MADE OF PRECIOUS METALS, PIPES, TOBACCO CASES NOT MADE OF PRECIOUS METALS, CIGARETTE PAPERS, CIGARETTE FILTERS, CIGARETTE TUBES, AND HAND-HELD MACHINES FOR ROLLING AND MAKING CIGARETTES	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	0654489
FOREIGN REGISTRATION COUNTRY	BX
FOREIGN REGISTRATION DATE	02/01/2000

FOREIGN EXPIRATION DATE	06/24/2009
STANDARD CHARACTERS OR EQUIVALENT	NO
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	034
DESCRIPTION	
CIGARETTES, CIGARS, CIGARILLOS, TOBACCO, MATCHES, LIGHTERS AND ASHTRAYS NOT MADE OF PRECIOUS METALS, PIPES, TOBACCO CASES NOT MADE OF PRECIOUS METALS, CIGARETTE PAPERS, CIGARETTE FILTERS, CIGARETTE TUBES, AND HAND-HELD MACHINES FOR ROLLING AND MAKING CIGARETTES	
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	0654489
FOREIGN REGISTRATION COUNTRY	BX
FOREIGN REGISTRATION DATE	02/01/2000
FOREIGN EXPIRATION DATE	06/24/2009
ADDITIONAL STATEMENTS SECTION	
PRIOR REGISTRATION(S)	"Applicant claims ownership of U.S. Registration Number(s) 1686628, 2422437, 2950896."
MISCELLANEOUS STATEMENT	Applicant has amended the application to delete the Section 1(b) ("intent to use") basis of the application and to claim ownership of prior registrations. It is believed that the above application is now in condition to be passed for publication, but if there are any inquiries or further requirements, it would be appreciated if the Examining Attorney would call the undersigned.
SIGNATURE SECTION	
DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/BT/
SIGNATORY'S NAME	BREWSTER TAYLOR
SIGNATORY'S POSITION	ATTORNEY
DATE SIGNED	06/07/2007
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Jun 07 18:09:41 EDT 2007
TEAS STAMP	USPTO/ROA-207.188.235.181 -20070607180941259605-771 05156-3705437a9695531559e 9fe092389f728929-N/A-N/A- 20070607175309876406

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77105156** has been amended as follows:

Classification and Listing of Goods/Services

Applicant hereby amends the following class of goods/services in the application as follows:

Current: Class 034 for CIGARETTES, CIGARS, CIGARILLOS, TOBACCO, MATCHES, LIGHTERS AND ASHTRAYS NOT MADE OF PRECIOUS METALS, PIPES, TOBACCO CASES NOT MADE OF PRECIOUS METALS, CIGARETTE PAPERS, CIGARETTE FILTERS, CIGARETTE TUBES, AND HAND-HELD MACHINES FOR ROLLING AND MAKING CIGARETTES

Original Filing Basis: 1(b); and 44(e).

Proposed: Class 034 for CIGARETTES, CIGARS, CIGARILLOS, TOBACCO, MATCHES, LIGHTERS AND ASHTRAYS NOT MADE OF PRECIOUS METALS, PIPES, TOBACCO CASES NOT MADE OF PRECIOUS METALS, CIGARETTE PAPERS, CIGARETTE FILTERS, CIGARETTE TUBES, AND HAND-HELD MACHINES FOR ROLLING AND MAKING CIGARETTES

Filing Basis: 44(e).

Deleted Filing Basis: 1(b)

Procedural Matters/Informalities

Applicant proposes to amend the following:

Original: VAN NELLE TABAK NEDERLAND BV, a corporation of Netherlands, having an address of SLACHTEDIJK 28A 8501 ZA JOURE, NL .

Proposed: VAN NELLE TABAK NEDERLAND BV, a corporation of Netherlands, having an address of SLACHTEDIJK 28A 8501 ZA JOURE, Netherlands .

Additional Statements

"Applicant claims ownership of U.S. Registration Number(s) 1686628, 2422437, 2950896."

Applicant has amended the application to delete the Section 1(b) ("intent to use") basis of the application and to claim ownership of prior registrations. It is believed that the above application is now in condition to be passed for publication, but if there are any inquiries or further requirements, it would be appreciated if the Examining Attorney would call the undersigned.

Declaration Signature

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Response Signature

Signature: /BT/ Date: 06/07/2007

Signatory's Name: BREWSTER TAYLOR

Signatory's Position: ATTORNEY

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 77105156

Internet Transmission Date: Thu Jun 07 18:09:41 EDT 2007

TEAS Stamp: USPTO/ROA-207.188.235.181-20070607180941

259605-77105156-3705437a9695531559e9fe09

2389f728929-N/A-N/A-20070607175309876406